



Docket No. 104.002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
In re Patent Application of:

Eugene S. Pearlman

SERIAL NO.: 09/303,315

Group Unit:1631

FILED: April 30, 1999

Ex: Lori A. Clow

FOR: ALGORITHMIC TESTING IN LABORATORY MEDICINE

RESPONSE AFTER FINAL UNDER 37 CFR 1.116

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Applicant files the following amendments in response to the following papers:

1) Communication dated September 17, 2003 in which the Examiner rejected claims 1-4, 21, 23, 24 (responding to August 25, 2003 Response) citing the art cited **Office Action issued February 5, 2003;**

2) Communication dated July 16, 2003, in which the Examiner rejected claims 1-4, 21, 23, 24 under 35 USC section 112, first paragraph and second paragraph. **This paper does not state in any form that there were any OUTSTANDING rejections based on prior art cited in Office Action of February 5, 2003 (RESPONDING to Response filed**

May 5, 2003). Applicant's conclusion is that this Examiner has not followed proper procedure and principles of compact prosecution. MPEP 2164.04.

- 3) On April 30, 2003 , the examiner issued a Communication, reporting the substance of an interview between Applicant's Attorney and Examiner Lori Clow and her Supervisor Michael Woodward. This Communication states:

"Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant was advised to amend the claim language to reflect the invention as described. Applicant will provide details regarding the basis of support for the amendments. Specifically, applicant was advised to amend claims to read on input from a physician and a method to optimize clinical chemical analysis of a patient."

Applicant made the above recommended amendments in the claims and filed them in the Response dated May 5, 2003. In response, Examiner Clow called Applicant's attorney on July 8, 2003, and informed the attorney that the Examiner was issuing an allowance on the amendments. **The Examiner seems to have changed her mind. She has NOT provided specific reasons for her rejection based on prior art.**

4) Another example of failure to follow proper Examination Procedure by this Examiner is the Examiner's failure to respond to applicant's attorney to explain why she withdrew her allowance. Specifically, on July 8, 2003, Examiner Lori Clow called applicant's attorney and Stated that based on her examination of the May 5, 2003, she was issuing an allowance. Examiner Clow indicated that she required an Examiner's amendment regarding canceling claim 22. Applicant's attorney agreed to the amendment. Applicant's attorney informed applicant the news of the impending allowance.

Despite this, On July 16, 2003, Examiner Clow issued a Final Office Action raising the issue of new subject matter (Under Section 112) in reference to the claim amendment "without the intervention of a technician".

Applicant's attorney called the Examiner on July 18, 2003 to discuss the above Final Office Action (in view of the allowance by the Examiner in her July 8, 2003 telephone). Applicant's attorney left messages for Examiner Clow about the Final Action, and asked the Examiner to call her back. The Examiner did not do so. Therefore, applicant's attorney called the Examiner's Supervisory Patent Examiner on July 21, 2003 and presented the facts (a telephone allowance on July 8, 2003 followed by a Final Action on July 16, 2003) to Dr. Michael P. Woodward. Dr. Woodward indicated that he would request the file and review it and give his comments by calling the applicant's attorney as soon as he could.

Dr. Woodward has not called.

In the interest of moving the prosecution forward, Applicant filed a Response to the July 16, 2003 Office Action. The Examiner withdrew the rejection as stated in her Office Action of September 17, 2003, and then reinserted her art based rejection from the February 5, 2003 Office Action!!

In the interest of compact prosecution, applicant is filing yet another Request for Continued Examination to address specifically the art rejections of the February 5, 2003 Office Action.

A Petition for Extension of Time for one month with fee is also included herewith.